

REMARKS

Entry of the foregoing and reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. §1.112, are respectfully requested in light of the following remarks.

The acknowledgments of the claims for foreign priority, of the certified copy of the priority document and of the September 27, 2004 Information Disclosure Statement and Form PTO-1449 are noted, with appreciation.

Claims 1-44 are now in the application. New Claims 27-44 have been added in order to claim in separate claims subject matter which was previously claimed in claims 2, 5-7, 9, 12, 13, 15, and 19-20. It is believed that placing the advantageous or preferred amounts in separate claims is in better keeping with U. S. patent practice than maintaining various decreasing amounts in a single claim. European-style "characterized in that" phraseology has also been eliminated and other linguistic changes have been made to better suit U. S. practice. These are clarifications and do not limit or expand the scope of the claims.

Substantively, claim 1 has been amended by specifying therein that the polyisocyanate composition has a functionality of greater than 3. At least original claim 2 provides support for the new language added to claim 1. The significance of this functionality is discussed later in this response.

Claim 25 has been rejected under 35 U.S.C. §101 as being an improper process claim which does not recite any steps. This European-style use claim has been rewritten. It is now directed to a method of preparing a paint or other coating comprising incorporating therein a composition as claimed in claim 1. The claim thus

now recites a step and is believed to be a proper method claim. As there is no other rejection of claim 25, it is believed that it is now in allowable form.

Claims 1-5, 7-14 and 19-23 have been rejected as purportedly anticipated by Laas et al. U. S. Patent No. 5,750,629. Applicant submits that, on the contrary, not one of the present claims is anticipated by Laas et al. '629.

Example 1 of the Laas et al. '629 patent discloses a dimerization reaction which is carried out in the presence of an alcohol, more precisely a diol (1,3-butanediol). The alcohol reacts with the isocyanate functions and leads to the formation of carbamates or polyurethanes. (See Laas et al. '629 column 3, lines 21-30, where various alcohols, including "the isomeric butanediols" are shown as preferred cocatalysts.) The alcohol reacts with the isocyanate functions and leads to the formation of carbamates or polyurethanes. Carbamates and polyurethanes are very well-known to (i) increase viscosity and (ii) lower the functionality of the final polyisocyanate composition.

The composition disclosed by Laas et al. '629 is therefore not the same because of the presence of a diol during the reaction. Laas et al. do not provide applicant's low viscosity polyisocyanate composition having high functionality. Claim 1 herein now specifies a functionality of greater than 3, claim 2 specifies a functionality of greater than 3.5 and new claim 29 specifies a functionality of greater than 4. Furthermore, the present inventor has calculated the functionality of the residue obtained by Laas et al. '629 in their Example 1 as being 2.72, which is below the amount specified in applicant's independent Claim 1. Determination of functionality is described in detail in applicant's specification on pages 15-16; however, if the Examiner would like to have the inventor's calculation as applied to

Laas et al. '629 presented in the form of a 132 declaration, she is asked to contact the undersigned who will arrange to have an appropriate declaration submitted.

In view of the foregoing, it is submitted that the 102(b) rejection is untenable and should be withdrawn. It is also noted that claims 6, 15-18 and 24-26 have not been rejected under 35 U.S.C. §102(b).

Claims 1, 15-18, 24 and 26 have been rejected under 35 U.S.C. §103(a) as being purportedly unpatentable over (obvious from) Laas et al. U. S. Patent No. 5,143,994 in view of Saunders.

Applicant submits that this rejection is untenable and that all of the present claims are free of this rejection.

Laas et al. '994 teaches essentially the same thing as Laas et al. '629. Use is again made by Laas et al. of a diol in the preparation of the polyisocyanate compositions. In Example 1 of Laas et al. '629, the diol was 1,3-butanediol; in Example 1 of Laas et al. '994, the diol is 2,2,4-trimethyl-1,3-pentanediol. Therefore, Laas et al. does not differ from the present claims only by not specifying the blocking agents but also by the presence of an alcohol, thereby leading to the formation of polyurethanes and carbamates, which increase viscosity and lower the final functionality as described above.

Consequently, it is far from obvious to use blocking agents in combination with Laas et al. '994, a combination which does not arrive at the novel and non-obvious polyisocyanate composition of the invention because the instant composition is prepared without the use of any alcohol and has a functionality of greater than 3 unlike Laas et al.'s product.

It is further noted that there is no rejection outstanding against claim 6. Claim 6 and its dependent claims, claims 31-32, thus appear to be directed to allowable subject matter. Likewise, no art-based rejection has been made of claim 25, which is therefore believed to be patentable over the art of record.

In view of the foregoing, it is believed that all rejections have been overcome and that allowance of all of the claims is next in order.

Respectfully submitted,

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